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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,100	07/26/2000	Adam M. Gersting	426882000500	8237

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ACCENTURE C/O MORRISON & FOERSTER  
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[REDACTED] EXAMINER

BOYCE, ANDRE D

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/626,100	GERSTING, ADAM M.
	<b>Examiner</b>	<b>Art Unit</b>
	Andre Boyce	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 08 May 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 8, 2003 has been entered.
2. Claims 1 and 9 have been amended. Claims 1-16 are pending.
3. The previously pending objection to the specification has been withdrawn.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case independent claim 1 only recites an abstract idea. The recited steps of determining key considerations, providing key processes, and applying these key considerations and processes to the system design does not involve, use, or advance the technological arts (i.e., database, processor, electronically, etc.), since the steps could be performed using pencil and paper. Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed invention produces a solution to the system design problem, thereby producing a useful, concrete, and tangible result, but not within the technological arts as explained above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxter et al (USPN 6,356,903), in view of Downs et al (USPN 6,574,609).

As per claim 1, Baxter et al disclose a method for designing a coordinated content management and delivery system (web based content management system, see Figure 1) comprising the acts of, determining key considerations (requested content) related to the client environment (see column 4, lines 38-42), the key considerations comprising what content related processes are needed to support publishing (i.e., assembly procedure 70, see column 6, lines 56-58); providing key processes (organizational and format components) for use in developing a solution to a system design problem (see column 5, lines 48-51), the system design problem being the determination of what content management and delivery products and processes to implement and how to implement them (i.e., each responsible contributor creates, edit, and/or designs the components and overall format of the content and delivery, see column 5, lines 44-55), wherein the key processes comprise capture and use of customer's user preferences (i.e., personalization process, see column 17, lines 8-13), application of business rules to user

preferences to determine future content development (i.e., format rules as determined by content creators and designers, see column 4, lines 54-67), access control for the content management (see column 5, lines 34-36); metadata capture including author, date of creation, and topic (see column 7, table 2); and applying these key considerations and processes to the system design problem with the assistance of a framework (outlines and associated templates, see column 5, lines 51-54) showing basic content management and delivery element relationships, whereby such a solution to the system design problem can be produced (see column 6, lines 15-27). Baxter et al does not explicitly disclose what combination of channels and related devices are to be supported. However, Baxter et al discloses using a variety of delivery systems (channels), and Downs et al discloses a content distribution system 100 deployed using both new and existing distribution channels (see column 12, lines 36-39). Both Baxter et al and Downs et al are concerned with the effective content management, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include what combination of channels and related devices are to be supported, in the Baxter et al system, as seen in Downs et al, in order to efficiently distribute the content via the most effective channel.

As per claim 2, Baxter et al disclose the solution to the system design problem includes facilities whereby coherent sales, training, electronic learning or marketing campaigns are efficiently generated to web-based and other clients (training system, see column 4, lines 20-24).

As per claim 3, Baxter et al disclose the solution to the system design problem includes facilities whereby transaction processing and execution are monitored and captured for adding data to a target customer's profile (user profile, see column 17, lines 18-24).

Claims 9-11 are rejected based upon the rejection of claims 1-3, since they are the system claims corresponding to the method claims.

8. Claims 4-8, and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxter et al (USPN 6,356,903), in view of Downs et al (USPN 6,574,609) as applied to claims 1 and 9 above, in further view of Swartz et al (USPN 6,236,994).

As per claim 4, Baxter et al does not explicitly disclose the framework is a formalized framework for supporting assessment of needs, and planning and implementing of content management solutions. Swartz et al disclose planning based on various information sources and decision points (see column 7, lines 58-62). Swartz et al also discloses a framework to build, augment, and represent (i.e. assess, plan, and implement) the integration knowledge (content) base (see column 18, lines 55-64). Both Baxter et al, and Swartz et al are concerned with management of content (i.e. knowledge, data, and information), therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a formalized framework in Baxter et al, as seen in Swartz et al,

thereby having a construct to assist the user in consistently delivering suitable content management solutions.

As per claims 5-8, Baxter et al does not explicitly disclose the formalized framework and associated processes and considerations being used to; guide discussions about desired capabilities of the desired content management and delivery system, develop a meaning of content management and a set of process considerations required for the definition, assess the business capabilities to be supported, and achieve an effective design solution including an assessment of available products and services. Swartz et al disclose the ability to visualize and explore (discuss) past, present, and potential decisions based on the content (see column 7, lines 49-55). Further, Swartz et al disclose implementing the system in one or more phases of complexity, based on the problem (i.e. developing and assessing the content management to achieve an effective design solution, see column 8, lines 45-49). Both Baxter et al, and Swartz et al are concerned with management of content (i.e. knowledge, data, and information), therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the uses of the formalized framework in Baxter et al, as seen above, thereby providing the user with a construct to either avoid, recognize, or reflect on problems that could cost the user time and/or money (see Swartz et al column 7, lines 58-67, and column 8, lines 1-7).

Claims 12-16 are rejected based upon the rejection of claims 4-8, since they are the system claims corresponding to the method claims.

***Response to Arguments***

9. In the Remarks, with respect to claims 1 and 9, Applicant argues that neither Baxter et al nor Swartz et al teach Applicant's invention as amended. The Examiner respectfully disagrees with Applicant's assertion and submits that Baxter et al indeed disclose the limitations of amended claims 1 and 9, as seen in the above rejections, except for "...what combination of channels and related devices are to be supported..". For this limitation, the Examiner submits Downs et al, as seen in the above rejections.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (703) 305-1867. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*adb*  
adb  
July 18, 2003

*Susanna Diaz*  
*Susanna Diaz*  
*Primary Examiner*  
*A.U. 3623*